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146.1364

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: : C. Yaen
BORDON-PALLIER et al :
Serial No.: 09/831,426 :
Filed: May 8, 2001 : Group: 1642
For: HUMAN...PROTEIN :

600 Third Avenue
New York, N.Y. 10016
March 24, 2003

"Express Mail" mailing label number EV 243503646 US
Date of Deposit March 25, 2003

RESPONSE

Hon. Commissioner for Patents
Washington, D.C. 20231

Sir:

Responsive to the office action of February 26, 2003, Applicants request reconsideration of the application in view of the remarks presented herein.

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The claims in the application are claims 1 to 16, no other claims having been presented.

The Examiner has required a seven-way restriction requirement between 5 DNA sequences, claim 14 drawn to a plasmid and claims 10, 11, 15 and 16 drawn to a polypeptide having the function of hTFIIIA and a method of making and using the polypeptide. The Examiner was of the opinion that groups I to VII did not relate to a single general inventive concept under PCT Rule 13.1 as they lacked the same or corresponding special technical features since the Examiner was of the opinion that the

DNA sequences of inventions I to V are unrelated structurally, functionally and chemically and the method of making and using the protein and the protein are different.

Applicants vigorously traverse this restriction requirement since the European Patent Office has conducted the international search and the international preliminary examination report and did not find lack of unity as the legal basis. It is believed that all of the claims should be examined in the same application since the MPEP states in section 1893.03(d) "Examiners are reminded that unity of invention (not restriction) practice is applicable in international applications (both chapter I and II) and in national stage filed under 35 USC 371 applications. Restriction practice continues to apply to U.S. national applications filed under 35 USC 11(a)." This application has been filed under 35 USC 371 and therefore, the issue should be unity of invention and not restriction.

Applicants believe that the Examiner is misinterpreting Rule 13 of the PCT Rules and that the present application deals with a group of invention linked to form a single general inventive concept as provided by Rule 13 of the PCT Rules. The MPEP states "A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involve at least one common or corresponding special technical feature. The expression "special technical features" is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art."

Claims 1 to 9 concern DNA sequences which are closely related in that they all share at least a functional relationship as they all code for a protein having the biological function of human transcription factor hTFIIIA. Therefore, there is at least one common technical feature for these claims and they should be examined in the same application. This view is in line with Section 1850 of the MPEP wherein it is stated "Further, claims directed to the selected sequences will be examined with claims drawn to any sequence combinations which have a common technical features with the selected sequences." This is the case for claims 1 to 9 and therefore, they should all be examined together.

With respect to the group drawn to the polypeptide having the function of hTFIIIA, a method of using the protein for diagnosis and treatment, Applicants' opinion is that claims 1 to 10 should be in a single group as forming a group of inventions linked to form a single general inventive concept as stated in Section 1850 of the MPEP "Further, claims directed to the selected sequences will be examined with claims drawn to any sequence combinations which have a common technical feature with the selected seequences. Nucleotide sequences encoding the same protein are considered to satisfy the unity of invention standard and will continue to be examined together." Therefore, claims 1 to 10 should all be examined together.

With respect to process claim 11 directed to the preparation of hATFIIIA recombinant protein, Applicants feel that claim 11 should be grouped with claims 1 to 10. Combinations of different categories of claims can clearly belong to a single group of inventions. It is stated in the MPEP, Section 1850 "The method for determining unity of

invention under PCT Rule 13 shall be construed as permitting, in particular, the inclusion of anyone of the following combination of claims of different categories in the same international application...(C) In addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed to carrying out the said process, it being understood that a process is specially adapted for the manufacture of a product if it inherently results in the product and that an apparatus or means is specifically designed for carrying out a process if the contribution over the prior art over of the apparatus or means corresponds to the contribution the process makes over the prior art."

The process of claim 11 is specially adapted for the manufacture of polypeptides of claim 10 and the means designed for carrying this process includes DNA sequences of claims 1 to 19. The expression vector of claim 13 and host cells of claim 13. Therefore, according to the Patent Office's guidelines, claims 1 to 13 should belong to the same group of inventions.

Claim 14 is drawn to a plasmid deposited under CNCM I-2071 which plasmids share structural and functional features with claims 1 to 9 as containing a DNA sequence coding for a protein having the biological function of human transcription factor hTFIIIA and therefore, it should belong in the same group. Claims 15 and 16 are drawn to the use of the DNA sequence and polypeptides of claims 1 to10 and therefore, should belong to the same group. In other words, all of the claims should be examined in the same

application as there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature and the unity complies with 13 of the PCT.

However, in order to be fully responsive to the office action, Applicants elect with traverse the invention of group I which includes claims 1 to 3, 12, 13, 15 and 16. However, it is requested that the restriction requirement be revised with respect to the above arguments. Since the first office action was merely a restriction requirement, Applicants request a prompt examination on the merits.

Respectfully submitted,
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Enclosure